UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,663	06/28/2001	Steven G. Smith	BS00-354	2039

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ART UNIT	PAPER NUMBER
2152	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/892,663	SMITH ET AL.
	Examiner	Art Unit
	Dohm Chankong	2152

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _16 April 2002_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
  closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-22_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-22_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
  application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _5, 10/12/2001_.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1> Claims 1-22 are presented for examination.

Double Patenting

2> The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3> Claims 1-22 of this application ["the '663 application"] are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 09/892,736 ["the '736 application"]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the substance of the independent claims of the '663 application can clearly be found in the claims of copending '736 application. For instance, claim 1 of the '663 application can be found in claims 1, 2 and 4 of the '736 application; claim 9 is similar to claim 11 of the '736 application; claim 14 is similar in substance to claim 15; claim 19 is similar in substance to claim 23 of the '736 application, with limitations merely reworded; and claim 22 is similar in substance to claim 28 of the '736 application.

The main difference between claims 14 and 22 of the '663 application and claims 15 and 28 of the '736 application deal with a browser either (a) being launched by the user or (b) launched from a command by the systems interface. In either case, the outcome of each action is the same; that is, the browser launched and is then used to access an intranet or legacy systems at a separate network address and therefore, is not patentably distinct from each other.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4> The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5>   Claims 19-21 are rejected under 35 U.S.C § 102(e) as being anticipated by Devine et al,

U.S Patent No. 6.598.167 ["Devine"].

As to claim 19, Devine discloses a method for permitting a user to access data [column 2

<lines 55-60>], comprising:

authenticating a computer attempting to log onto a systems interface to legacy

systems [column 8 <lines 31-34>];

providing access to the systems interface, the systems interface corresponding to at

least one network address [Figure 1 <items 17,24> | column 13 <lines 29-35> | column 13 <line 62>

to column 14 <line 7> where: Devine's DMZ is comparable to the systems interface];

detecting an attempt to access an intranet, wherein the attempt comprises a user

launching a browser [Figure 1 <items 14,30> | column 12 <lines 28-32>];

determining whether to grant the computer access to the intranet [column 12 <lines 35-

37> | column 13 <lines 62-63> where: the server attempts to authenticate the client]; and

routing communications from the computer from the systems interface to a separate

network address corresponding to the intranet [Figures <1,5> | column 9 <lines 20-37> |

column 13 <lines 39-40> where: the TCP/IP in the message format references a network

address for the intranet].

6>   As to claim 20, Devine discloses the method claim 19, wherein the systems interface

comprises a first server having a first network address and a second server having a second

network address, wherein the first server provides a protocol interface between the computer

and the second server, and wherein the second server processes requests and generates legacy

transactions [Figure 5 <items 17,26,20> | column 8 <lines 17-30> | column 8 <line 61> to column 9

<line 5> | column 23 <lines 7-58> where: Devine's web server is comparable to the first server,

Devine's dispatcher server is comparable to the second server, that generates transactions to

the legacy systems].

7>   As to claim 21, Devine discloses the method of claim 19 wherein the step of

determining comprises confirming that a user of the computer is logged into the systems

interface [column 24 <lines 20-25>].

Claim Rejections - 35 USC § 103

8>   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

9>   Claims 1-3, 5-18, 22 are rejected under 35 U.S.C § 103(a) as being unpatentable over

Willis, Jr. et al, U.S Patent No. 6.738.815 ["Willis"], in view of Devine.

10>   As to claim 1, Willis discloses a system for permitting a user to access data on a legacy

system and an intranet [abstract], comprising:

     a computer operable by the user to access information stored on the legacy system

[Figure 5 <item 14> | column 3 <lines 6-24>]; and

a systems interface coupled to the legacy systems [column 3 <lines 17-33> | column 5 <lines 18-36>],

wherein the systems interface comprises at least one network address that can be accessed by the computer [column 6 <lines 6-9> | column 8 <lines 3-25>],

wherein the systems interface comprises a first server for managing protocol regarding the computer and a second server for generating transactions regarding the legacy systems [column 3 <lines 25-33>].

Willis discloses that the systems interface is adapted to route communications from the computer from the at least one network address to a separate network address corresponding to an intranet [Figure 28 | column 8 <lines 28-35> | column 9 <lines 46-58> | column 10 <lines 40-48> | column 11 <lines 60-67> where: the communications is routed from a network address of the client PC to the separate network address of the TechNet Server located on an intranet] but does not explicitly state routing of communications upon detecting that the user has launched a browser on the computer.

12> Devine teaches routing communications upon detecting that a user has launched a browser on the computer [column 12 <lines 28-47> | column 13 <line 62> to column 14 <line 7>]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Devine's browser detection capability into Willis to provide handshaking functionality between Willis' client and server systems, increasing the security of the communications.

13>   As to claim 2, Willis discloses the system of claim 1, wherein the computer

communicates with the systems interface over a wireline communications network [abstract

| column 9 <line 30> to column 10 <line 13>].

14>   As to claim 3, Willis discloses the system of claim 1, wherein the computer

communicates with the systems interface over a wireless communications network [abstract

| column 8 <lines 37> to column 9 <line 29>].

15>   As to claim 5, Willis does not disclose a system wherein the systems interface detects

that the user has launched a browser by receiving a message from the computer.

16>   Devine teaches a system wherein the systems interface detects that the user has

launched a browser by receiving a message from the computer [column 12 <lines 28-47> |

column 13 <line 62> to column 14 <line 7>]. It would have been obvious to one of ordinary skill

in the art at the time.the invention was made to incorporate Devine's browser detection

capability into Willis to provide handshaking functionality between Willis' client and server

systems, increasing the security of the communications.

17>   As to claim 6, Willis does not disclose a system wherein the systems interface detects

that the user has launched a browser by receiving a request to transfer to the separate

network address corresponding to the intranet.

18>   Devine teaches a system wherein the systems interface detects that the user has

launched a browser by receiving a request to transfer to the separate network address

corresponding to the intranet [column 6 <lines 39-43> | column 8 <lines 17-30> | column 13 <line

62> to column 14 <line 7>]. Devine implements his system to provide increased security for

accessing the intranet. Therefore, it would have been obvious to one of ordinary skill in the

art to implement Devine's network address transfer request to allow the server to verify the

user before forwarding the user onward to the intranet thereby allowing secure access to the

intranet.

19>   As to claim 7, Willis discloses the system of claim 1, wherein communications from

the computer are routed from the systems interface to the intranet comprises the second

server sending a command to the first server to route the computer to the separate network

address [Figures <1, 3> | column 3 <28-33> | column 5 <lines 24-63> | column 11 <line 59> to

column 12 <line 4> where: the TechNet server is equivalent in functionality to the second

server, and the protocol server is equivalent to the first server].

20>   As to claim 8, Willis discloses the system of claim 1, wherein the computer is running

application-specific client software to enable the computer to access the information from the

legacy system, wherein the computer is logged onto the systems interface using the

application-specific client software, and wherein, following the routing, the computer

remains logged onto the systems interface and the application-specific client software

remains an active application [column 6 <lines 51-63> | column 7 <lines 6-13> where: the GUI

layer is comparable to application-specific client software].

21>   As to claims 9-11, they do not teach or further define over the limitations recited in

claims 1-3. Therefore, claims 9-11 are also rejected for the same reasons as set forth in claims 1-

3, supra.

22>   As to claim 12, Willis discloses the system of claim 9, wherein the means for

providing an interface comprises at least one protocol server and at least one transaction

server, wherein the at least one protocol server provides an interface between the computer

and the at least one transaction server, and wherein the at least one transaction server

receives requests and generates legacy system transactions [column 3 <lines 6-33>].

23>   As to claim 13, Willis discloses the system of claim 12, wherein the means for

providing an interface issues at least one command, wherein the at least one command causes

the at least one protocol server to route communications from the computer from the first

network address to the second network address [column 8 <lines 7-36> | column 10 <lines 15-22

and 40-48>] but does not explicitly disclose that the command is issued in response to

detecting that the user has launched the browser.

24>   Devine teaches issuing a command in response to detecting that the user has launched

a browser [column 12 <lines 28-47> | column 13 <line 62> to column 14 <line 7> where: server

verifies user when browser is launched before routing the client to the intranet]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement Devine's browser detection functionality into Willis' command to allow client and server to establish secure connections before issuing the command to route the client onward to the intranet.

25>   As to claim 14, Willis discloses a method for accessing data, comprising:

logging a computer onto a systems interface that permits remote access of legacy data [abstract | column 3 <lines 14-24>];

accessing the systems interface at a first network address [column 9 <lines 46-55>];

accessing an intranet at a separate network address [column 11 <line 60> to column 12 <line 4> | column 14 <line 19 where: the TechNet server and legacy system are located on an intranet].

Willis does not explicitly disclose launching a browser, wherein the browser is launched by a user of the computer.

26>   Devine discloses a method for accessing data comprising launching a browser, wherein the browser is launched by a user of the computer [column 2 <lines 55-64> | column 12 <lines 28-31>]. It would have been obvious to implement a browser into Willis' method to allow users to access the remote systems over the public Internet.

27>   As to claim 15, Willis discloses the method of claim 14, wherein the computer is logged onto the systems interface over a wireline communications network [abstract | column 9 <line 30> to column 10 <line 13>].

28>   As to claim 16, Willis discloses the method of claim 14, wherein the computer is logged onto the systems interface over a wireless communications network [abstract | column 8 <lines 37> to column 9 <line 29>].

29>   As to claim 17, Willis discloses the method of claim 14, wherein the systems interface comprises a first server and a second server, wherein the first server provides an interface between the computer and the second server, wherein the first server has the first network address, wherein the second server is adapted to receive requests and generate legacy transactions, and wherein the second server has a second network address [Figures <3,5,6> | column 3 <lines 25-33> | column 9 <lines 46-65> | column 11 <lines 60-67].

30>   As to claim 18, Willis discloses the method of claim m17, wherein the computer is logged onto the first server [Figure 6].

31>   As to claim 22, Willis discloses a system for permitting a user to access data, comprising:

a computer employed by the user to access information from legacy systems, wherein

the computer executes application-specific client software to access the information from legacy systems [column 3 <lines 6-12> | column 5 <lines 47-63>].

a systems interface to the legacy systems, the systems interface including a protocol server and a transaction server [column 3 <lines 24-33>], the protocol server having a first network address and the transaction server having a second network address [column 9 <lines 46-65> | column 11 <lines 60-67>], wherein the protocol server is capable of issuing at least one message to cause communications from the computer to be routed from the first network address to the separate network address when access is granted [column 8 <lines 7-36> | column 10 <lines 15-22 and 40-48>], and wherein the application-specific client software remains an active application after access to the intranet is granted [column 6 <lines 51-63>].

Willis does not disclose a browser that can be launched by the user to initiate an attempt to access an intranet at a separate network address or that the protocol server is adapted to determine whether to grant the user access to the intranet in response to detecting that the user has launched a browser.

32>   Devine discloses a browser that can be launched by the user to initiate an attempt to access an intranet at a separate network address [column 12 <lines 28-31> | column 13 <lines 62-67>]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement Devine's browser detection functionality into Willis' command to allow client and server to establish secure connections before issuing the command to route the client onward to the intranet.

Devine also teaches a protocol server adapted to determine whether to grant the user access to the intranet in response to detecting that the user has launched a browser [column 12 <lines 28-36> | column 13 <lines 29-35>]. It would have been obvious to one of ordinary skill to implement Devine's security protocols into Willis' system to provide enhanced protection of the legacy systems from malicious attacks.

33>   Claim 4 is rejected under 35 U.S.C § 103 (a) as being unpatentable over Willis and Devine, in view of Butts et al, U.S Patent No. 6.233.541 ["Butts"].

34>   As to claim 4, Willis discloses the system of claim 1, wherein the at least one network address comprises a first IP address corresponding to the first server and a second IP address corresponding to the second server [Figure 20 | column 9 <lines 51-53> | column 10 <lines 5-7> | column 11 <line 60> to column 12 <line 10> | column 12 <lines 46-67> where: although, Willis does not specifically state that the second server has an IP address, a server having an IP address is well known in the art, and he does state that the second server has a separate address from the first server].

Willis discloses a legacy system and intranet with a separate address but does not explicitly disclose that separate network address comprises a third IP address.

35>   Butts teaches that a legacy system with an IP address [abstract | Figure 1 where: the legacy system is accessed using TCP/IP communications]. It would have been obvious to one of ordinary skill in the art to have implemented Willis' separate address as an IP address

to allow Willis' clients access to the legacy system and intranet across a persistent TCP/IP

connection, thereby permitting real-time bi-directional communication with the system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

U.S Patent No. 5.754.830 to Butts et al [abstract – web browser emulator for persistent

connection to a legacy host system];

U.S Patent No. 6.052.785 to Lin et al [column 2 <lines 27-40> - authorization system

for accessing remote data with implemented middle-tier management systems];

U.S Patent No. 6.763.376 to Devine et al [abstract – remote access of legacy data

systems over the Internet].

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Dohm Chankong whose telephone number is (703)305-8864.

The examiner can normally be reached on 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Follansbee can be reached on (703)305-8498. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-

9197 (toll-free).

DC

Dung C. Dinh
Primary Examiner